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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

003D.0068.U1(US)

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Jessica Pace

Application Number

10/539,914

Filed

11/14/2005

First Named Inventor

Drosebeke et al

Art Unit

2831

Examiner

Ngo, Hung V.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 31,686

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Mark F. Harrington
Signature

Mark Harrington

Typed or printed name

(203) 925-9400

Telephone number

1/21/08

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/539,914
Applicant(s): Droesbeke et al.
Filed: 11/14/2005
Art Unit: 2831
Examiner: Ngo, Hung V.
Title: Shielding Cage

Confirmation No.: 6534

Attorney Docket No.: 003D.0068.U1(US)
Customer No.: 29,683

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Arguments Accompanying Pre-Appeal Brief Request For Review

Sir:

Claims 15-21, 25-32, 36 and 37 were rejected under 35 U.S.C. §102(b) as being anticipated by Benzoni (US 5,416,668). Claims 22-24 and 33-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Benzoni (US 5,416,668).

The examiner stated that the limitation of “die cast” has been considered, but does not result in a structural difference. The examiner is incorrect. The independent claims of the present application **comprises a structural difference** which is not disclosed or suggested in the cited art.

Claim 15 claims that “the shielding cage is a die-cast member.” The examiner appears to have indicated that the limitation of the shielding cage being a die-cast member does not result in a structural difference. This is incorrect. The product claimed in claim 15 is different from the product disclosed in Benzoni. MPEP 2113 states:

“The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive

structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)"

In the present case, "wherein the shielding cage is a die-cast member" has structural attributes which the metal plated housing 20 of Benzoni does not have.

Benzoni merely discloses that the housing 20 comprises a molded non-conductive member; such as molded plateable engineering grade plastic (column 2, lines 26-27 and 38-40). Surfaces of the housing 20 are plated with an electrically conductive material, such as copper (column 3, lines 29-31). **A plastic member plated with metal is different from a die-cast member.** A die-cast member is more robust than a plastic member having a plated surface. A die-cast member has different electrical conductivity than a plastic member having a plated surface; plastic is electrically insulative. A die-cast member has less resistance to conduct heat than a plastic member having a plated surface. A plastic member is more resistant to heat conduction than a die-cast member. A die-cast member can absorb more energy than a plastic member having a plated surface, such as when heating a solder pin; the terminal resistance fuse point is higher for a die cast member. In view of all of these structural differences between what is disclosed in Benzoni and what is claimed in claim 15, it simply does not make sense for the examiner to state that there are no structural differences.

The structure of a die-cast member is different than the structure of a plastic member having a plated surface. Failure of the examiner to give the limitation "wherein the shielding cage is a die-cast member" patentable weight is reversible error. In the present case, the "die cast" is not "purely" a process limitation; it is also a structural limitation. Following MPEP 2113, in this case the manufacturing process steps clearly should be expected to impart distinctive structural characteristics to the final product. In this case, the product can only be defined by the process steps by which the product is made. MPEP 2113 states that the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, **especially** in this type of situation. Therefore, it appears to

be improper for the examiner not to consider the structure implied by the “die cast” member in this case.

Referring to MPEP 2131, “anticipation” requires that **each and every element** of the claimed invention be disclosed in a single prior art reference (emphasis added). In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Anticipation requires **identity** of the claimed invention (emphasis added). Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985). For anticipation, there must be **no difference** between the claimed invention and the reference disclosure (emphasis added). Scripps Clinic & Res. Found. V. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). The corollary of the rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

In the present case, the examiner has not proven that there is **identity** between the cited reference and the features of claim 15. In the present case, the examiner has not proven that **each and every element** of the claimed invention is disclosed in the cited reference. In the present case, the examiner has not proven that there are **no differences** between the claimed invention and the reference disclosure. Benzoni does not “anticipate” the features of claim 15. Therefore, claim 15 is patentable.

Independent claim 26 claims that “said walls and mounting tails comprise a die cast member.” Benzoni does not disclose or suggest walls and mounting tails which comprise a die cast member. Independent claim 37 claims that “said walls and said mounting tails are parts of a single die cast member.” Benzoni does not disclose or suggest walls and mounting tails which are parts of a single die cast member. In this case, the structural attributes of a die cast member distinguishes the claimed invention over the housing 20 comprised a molded non-conductive member (such as molded plateable engineering grade plastic) plated with an electrically conductive material (such as copper) described in Benzoni.

Again, a die-cast member is more robust than a plastic member having a plated surface. A die-cast member has different electrical conductivity than a plastic member having a plated surface; plastic is electrically insulative. A die-cast member has less resistance to conduct heat than a plastic member having a plated surface. A plastic member is more resistant to

heat conduction than a die-cast member. A die-cast member can absorb more energy than a plastic member having a plated surface, such as when heating a solder pin; the terminal resistance fuse point is higher for a die cast member. In view of all of these structural differences between what is disclosed in Benzoni and what is claimed in claims 26 and 37, it simply does not make sense for the examiner to state that there are no structural differences. **The product claimed in claims 26 and 37 is different from the product disclosed in Benzoni.** Benzoni does not disclose or suggest walls and mounting tails which comprise a die cast member as claimed in claim 26 or walls and mounting tails which are parts of a single die cast member as claimed in claim 37.

In regard to In re Stephens cited by the examiner, it merely states that "the presence of process limitations in product claims, which product does not otherwise patentably distinguish over the prior art, cannot impart patentability to that product." However, in the present claims, **the product does patentably distinguish over the prior art.** The structural attributes of a dies cast member patentably distinguish the claimed product over the product disclosed in Benzoni. Thus, the examiner's reliance on In re Stephens is misplaced. In regard to In re Van Geuns cited by the examiner, it merely states that "limitations are not to be read into the claims from the specification". However, this is not an excuse to not read the claim as a whole and not give patentable weight to the actual claim language; "die cast member".

For all of the foregoing reasons, it is respectfully submitted that all of the claims present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested.

Respectfully submitted,



Mark F. Harrington (Reg. No. 31,686)

Date

1/21/08

Customer No.: 29683

Harrington & Smith, PC

4 Research Drive

Shelton, CT 06484-6212

203-925-9400